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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,424	11/03/2003	David W. Johnson	CALW-004/01US	1511

58249 7590 09/22/2006

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EXAMINER
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ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/698,424

Applicant(s)

JOHNSON ET AL.

Examiner

Keith O. Robinson, Ph.D.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) 1,5 and 20-29 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2-4 and 6-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date June 21, 2006.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The amendments of claims 2-4 and 6-15 and the withdrawal of claims 1, 5 and 20-29, filed June 21, 2006, have been received and entered in full.
2. Claims 2-4 and 6-19 are under examination.
3. Claims 1, 5 and 20-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 21, 2006.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Response to Arguments***

5. Applicant's amendments, see 'Response', page 10, filed June 21, 2006, with respect to the 35 USC § 112, second paragraph rejection of claims 2-4 and 9-19 on page 2 of the Office Action mailed December 21, 2005, have overcome the rejection. The rejection has been withdrawn.
6. Applicant's arguments, see 'Response', pages 19-21, filed June 21, 2006, with respect to the 35 USC § 102 (b) rejection of claims 2-4 and 6-19 on pages 8-9 of the

Office Action mailed December 21, 2005, have overcome the rejection. The rejection has been withdrawn.

***Claim Rejections - 35 USC § 112, first paragraph – Written Description***

7. Claims 2-4 and 6-19 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed December 21, 2005. Applicant's arguments, filed June 21, 2006, have been fully considered but are not persuasive.

Applicant argues that the claims meet the written description requirement and that the descriptions of alfalfa lines representative of the present invention clearly fall within the norms of what is expected by one skilled in the art (see page 10, 2<sup>nd</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. Applicant is claiming the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and more erect stems than selected checks. There is no written description in the specification for each and every plant of the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and more erect stems. The specification only shows that Applicant was in possession of alfalfa germplasm 'CW 75046', 'CW 83201', 'CW 85029', and 'CW

95026' (see page 11, line 27 to page 12, line 6 and page 25, line 1 to page 45, line 14).

Thus, Applicant has not provided an adequate description of the claimed invention.

Applicant further argues that the Examiner "completely misses and mischaracterizes the true scope and meaning of the present invention" and that Applicant has "after much research and development for the first time discovered *Medicago sativa* alfalfa varieties with... 8% or greater faster recovery after spring green-up...and a 15% or greater more erect stem at late bloom" (see page 10, 3<sup>rd</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. Though Applicant alleges to have discovered *Medicago sativa* alfalfa varieties with... 8% or greater faster recovery after spring green-up...and a 15% or greater more erect stem at late bloom, Applicant does not claim any variety having 8% or greater faster recovery after spring green-up and a 15% or greater more erect stem at late bloom. Instead Applicant claims the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom and the specification does not provide an adequate written description for the claimed invention. The only varieties listed in the specification are alfalfa germplasm 'CW 75046', 'CW 83201', 'CW 85029', and 'CW 95026' (see page 11, line 27 to page 12, line 6 and page 25, line 1 to page 45, line 14).

Applicant argues that the Examiner's reliance upon *Vas-Cath Inc v. Mahurkar* is misplaced and strongly supports Applicant's position (see page 11, 2<sup>nd</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. *Vas-Cath Inc. v. Mahurkar* teaches that the purpose of the written description is for the purpose of **warning an innocent purchaser**, or other person using a machine, **of his infringement of the patent**; and at the same time, of taking from the inventor the means of practicing upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that **the patentee is required to distinguish his invention in his specification**.

Applicant has not distinguished the claimed invention from other alfalfa plants or varieties having the same traits nor does the specification describe the claimed invention in such a way as to warn an innocent purchaser of his infringement of the patent because Applicant claims the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom. The selection and identification steps do not provide a sufficient written description of the claimed invention because it does not prove that Applicant had possession of the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom.

Applicant's arguments with regard to MPEP § 2163 are persuasive (see page 12, 2<sup>nd</sup> paragraph of 'Response' filed June 21, 2006); however, the Examiner maintains the written description rejection for the reasons cited above.

***Claim Rejections - 35 USC § 112, first paragraph - Enablement***

8. Claims 2-4 and 9-19 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office Action mailed December 21, 2005. Applicant's arguments, filed June 21, 2006, have been fully considered but are not persuasive.

Applicant argues that it is irrelevant as to what the genetic, morphological and/or physiological characteristics of the parental lines used to develop the claimed invention because once one skilled in the art has access to the representative alfalfa varieties of the instant invention that person can develop further varieties (see page 13, 3<sup>rd</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. Again, Applicant refers to alfalfa varieties, but the claims are drawn to the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom and not any specific variety. Therefore, it would require undue trial and error experimentation for one skilled in the art to determine which combinations, if any, of the "2,864 elite alfalfa clones", "9,504 alfalfa plants", and "numerous elite alfalfa populations" would produce the claimed invention. Also, without knowing the genetic, morphological and/or physiological characteristics of the parental lines used to develop the claimed invention one skilled in the art would not know how to make and use the claimed invention.

Applicant further argues that by using the deposited parental clones it would not require undue experimentation to develop additional alfalfa varieties with the claimed

morphological characteristic (see page 13, last two lines to page 14, end of 2<sup>nd</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. Applicant has not claimed any deposited parental clones. The only deposited alfalfa plants are alfalfa germplasm 'CW 75046', 'CW 83201', 'CW 85029', and 'CW 95026' (see page 11, line 27 to page 12, line 6 and page 25, line 1 to page 45, line 14 of the specification). Applicant's claimed invention is the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom and not any specific variety.

Applicant argues each of the considerations set forth in *Wands* (see page 14, 3<sup>rd</sup> paragraph of 'Response' filed June 21, 2006), however, the Examiner will only address those factors cited in the previous Office Action mailed December 21, 2006.

Applicant argues that Applicant has developed a number of different alfalfa varieties which clearly meet the claimed ranges for the morphological traits (see page 15, last line to page 16, lines 1-2 of 'Response' filed June 21, 2006).

This is not persuasive. Applicant is claiming the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom and not any specific variety and not any specific alfalfa varieties.

Applicant's arguments with regard to the state of the prior art are persuasive (see page 16, 2<sup>nd</sup> paragraph of 'Response' filed June 21, 2006).



Applicant argues that it is predictable that one skilled in the art of plant breeding could develop additional alfalfa varieties with the claimed traits by using standard plant breeding procedures (see page 17, 1<sup>st</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. The Examiner has provided evidence of the unpredictability in development of improved alfalfa varieties (see pages 7-8 of the Office Action mailed December 21, 2006). In response to Applicant's argument based upon the age of the references (see page 17, 2<sup>nd</sup> paragraph of 'Response' filed June 21, 2006), contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Even though Applicant has deposited seed of four exemplary alfalfa varieties, the claimed invention does not claim these varieties and instead claims the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem at late bloom.

Applicant argues that the specification provides a great deal of direction as to how one skilled in the art could develop the alfalfa varieties of the present invention (see page 18, 3<sup>rd</sup> paragraph of 'Response' filed June 21, 2006).

This is not persuasive. The specification fails to provide any guidance regarding the genetic, morphological and/or physiological characteristics of the parents used in making the claimed invention.

***Conclusion***

9. No claims are allowed.
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.

September 6, 2006

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.